

The claims remaining in the application are 1, 3-5, 10-13, 15-17, and 22-24.

REMARKS

The Applicant would like to thank the Examiner for the quick and courteous March 19, 2004 Office Action, and particularly for the indication that claims 1, 3-5, 10, 11, 13, 15-17 and 22-24 are allowed, and that as noted in the Applicant's arguments, the amendment to delete lithium, potassium and cesium from claims 1 and 12 distinguishes over Atkinson.

The Applicant also appreciates the Examiner's provision of the Interview Summary of the telephone conversation of the Applicant's attorney with the Examiner on 01 March 2004. The Applicant agrees that this Summary is complete and accurate.

Objection to Claim 12

The Examiner objected to claim 12 because of the following informalities: Claim 12 contains ammonia as part of the Markush grouping twice, at lines 7 and 13.

The Examiner's attention is respectfully directed to the amendment to claim 12 where the second occurrence of ammonia in line 13 has been deleted. It is respectfully submitted that this deletion overcomes the objection; reconsideration is respectfully requested.

Rejection under 35 U.S.C. §103(a) over Atkinson

The Examiner has rejected claim 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP 63-199278 A for reasons of obviousness.

The Examiner finds that JP 63-199278 A teaches a heavy brine of calcium chloride which comprises ethylene diamine and/or diethylene triamine as corrosion inhibitors. The Examiner contends that they are both encompassed by the scope of applicant's compound of formula R¹R²R³N in claim 12. The Examiner alleges that JP 63-199278 A exemplifies the use of such corrosion inhibitors in brines of 29.9% calcium chloride, which are approximately 10.8 lbs/gal brines. The Examiner admits that JP 63-199278 A differs from the present invention in that brines as high as 11 lbs/gal are not disclosed. The Examiner nevertheless contends that it would be obvious to one of ordinary skill in

the art to utilize the corrosion inhibitors of JP 63-199278 A in brines of 11 lbs/gal density, since such brines would be expected to have similar corrosive properties with brines of close density, such as of 10.8 lbs/gal.

The Examiner further noted that a review of the record showed that a rejection of JP 63-199278 A was initially made in the office action of 5/20/03. Applicant amended the claims in the response of 7/11/03, and limited claim 12 by indicating the additive was selected from the Markush group at the end of the amended claim. Although this created issues under 35 U.S.C. §112, it was indicated in the office action of 9/23/03 that this distinguished over the JP 63-199278 A reference, since the intention was to limit the additive to the species of the Markush group at the end of the claim. Applicant amended claim 12 to incorporate the Markush grouping into the body of the claim in the amendment of 11/12/03, thus also including ethylene diamine and compounds of $R^1R^2R^3N$ as possible additive species. This again rendered JP 63-199278 A as prior art over claim 12, however such was not instantly recognized. This is corrected in the present office action.

The Applicant must respectfully traverse.

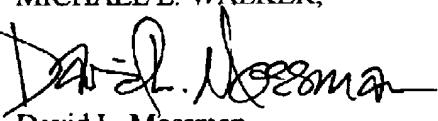
To support an obviousness rejection, the Examiner has the initial burden of establishing a *prima facie* case of obviousness of the pending claims over the cited prior art, *In re Oeticker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

The Examiner's attention is respectfully directed to the amendments to independent claim 12 herein where nitrogen has been deleted as a possible substituent for R^1 R^2 or R^3 in the formula $R^1R^2R^3N$, and where ethylenediamine has been deleted from the Markush listing. It is thus respectfully submitted that the formula $R^1R^2R^3N$ no longer encompasses ethylene diamine and/or diethylene triamine of JP 63-199278 A. It is thus respectfully submitted that the invention as recited in the amended claims is neither suggested by nor obvious from the reference.

The Applicant would respectfully submit that the claims as amended are therefore allowable over JP 63-199278 A, and that the Examiner has not established a *prima facie* case of obviousness of the claims as amended over the JP 63-199278 A reference. Reconsideration is respectfully requested.

It is respectfully submitted that the amendments and arguments presented above overcome all of the rejections. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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